

Attorney Docket No. 1267/US/5  
USPTO Facsimile No. (703) 872-9306

### REMARKS

Applicant thanks the Examiner for the thorough and comprehensive review of the pending claims in the present matter. Since the present matter is related to two patents (U.S. Patent No. 6,411,965 (the "965 Patent") and U.S. Patent No. 5,799,320 (the "320 Patent")) currently being asserted in patent litigation and Reexamined by the Patent Office, the volume and magnitude of prior art may be greater than that which is common. In any event, Applicant believes it has a duty to disclose the prosecution of the related Reexaminations in the present and related matters and appreciates the Examiner's continued and diligent review of the same. Should the Examiner not desire to receive the communications between EdiSync and the Patent Office regarding the Reexaminations of the '965 Patent and/or the '320 Patent, please notify Applicant's attorney in writing.

This amendment and response is filed in response to the Office Action (OA) of 1 October 2004, which set a shortened statutory period for replying of three (3) months. As such, a petition and fees for extension of time of three months is being submitted herewith. Upon entry of the present amendments to the claims, claims 1-31 remain pending. In view of the following comments, expedited allowance of these claims is earnestly solicited.

In the OA, each of claims 1-31 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of the "965 Patent" and claims 1-20 of the "320 Patent". Since the present application and both the '965 Patent and the '320 Patent are commonly owned and assigned to EdiSync Systems LLC, applicant submits herewith a terminal disclaimer in compliance with 37 C.F.R. 1.132(c) and respectfully requests withdrawal of the double patenting rejection.

Also, claims 22-29 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. The asserted indefiniteness arises from a typographical error, which has been corrected in the above amendments to the claims by having claim 22 depend from claim 19 instead of claim 1. Hence, the present amendment to claim 22 should not be considered as a narrowing amendment because it is being made for the purpose of correcting a known and readily identifiable (as demonstrated by the Examiner) typographical error. In view of such amendment, the § 112 rejection is rendered moot and withdrawal of the same is requested.

Claims 1-3, 6-16, 19, 22-24, 30 and 31 were rejected under 35 U.S.C. 102(b) as being anticipated by Sarin et al in "Computer-based Real Time Conferencing Systems" as part of a text edited by Grief in Computer-supported Cooperative Work: A Book of Readings. Applicant

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respectively traverses this rejection. Similarly, claims 4-5, 17, 18, 20-21, and 25-29 were rejected under 35 U.S.C. 103 (a) as being unpatentable over Sarin et al as applied to claim 1-2, 13, 19 and 22-24 above. As such, the Examiner relies solely upon Sarin in finding each of the pending claims anticipated by or obvious in view of Sarin.

Further, in view of the above amendments to the claims, the Declaration of Gary J. Nutt, dated 8 September 2004, and the Second Declaration of Gary J. Nutt, dated 15 March 2005, each of the presently pending claims are patentable over and not anticipated by Sarin. The First and Second Declarations of Dr. Nutt were previously submitted to the Patent Office, in conjunction with the prosecution of the present application, in Information Disclosure Statements dated 6 October 2004 and 23 March 2005, respectively. For the convenience of the Examiner, copies of the First and Second Declarations are submitted herewith. The Examiner is respectfully requested to review such Declarations in view of the present amendments to the claims.

Further, in related U.S. Patent Reexamination No. 90/006940 (a reexamination of the '320 Patent), which is presently pending before the Patent Office, Applicant has submitted Responses to the substantive Office Actions of 9 July 2004 and 27 October 2004. Copies of each of these Office Actions and Applicant's Responses thereto as well as a Supplemental Response dated 15 March 2005 have been submitted to the Patent Office, and listed in Information Disclosure Statements, for consideration by the Examiner in the present matter. The Examiner is requested to review the Remarks provided in such Responses when considering the patentability of the presently amended claims over Sarin and the other prior art of record cited in the 90/006940 and also in related Reexamination No. 90/006941 (a reexamination of the '965 Patent).

More specifically, as set forth in detail in Dr. Nutt's Declarations, Sarin does not teach, disclose, mention or suggest to one of ordinary skill in the art, by and before 23 August 1989 (the claimed priority date for the present application), apparatus which utilize a processor in a personal computer to provide an update for a file to two or more user devices substantially contemporaneously with the execution of an edit for the file. Therefore, since each of the presently pending claims, the specific elements and limitations of which are set forth above, generally recite the preceding limitations, each pending claim is patentable over and neither anticipated by nor obvious in view of Sarin.

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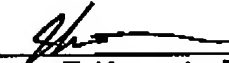
Further, regarding the rejections of claim 17 and 18, the Examiner stated that he "finds no support in the specification to determine proper interpretation" of the limitations recited in these claims. Support for such claim construction may be found in the drawing Figures, for example, Figure 2, as well as in Figure 3A, operation 102 and in the specification at page 12, lines 15-17 and page 13, lines 16-25.

In view of the above claim amendments and remarks, each of the pending claims 1-31 is patentable over Sarin and the cited prior art of record. The issuance of an expedited Notice of Allowance is respectfully requested.

Should the Examiner have any questions concerning the above remarks, the Declarations of Dr. Nutt or any other issue concerning the present application, please contact the undersigned attorney.

Dated: 3/29/05

Respectfully submitted,

  
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